UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

al/apb

Mailed: July 25, 2006

Opposition No. **91163702**

Davinci Dental Studios, Inc.

v.

Contessa da Vinci s.r.l.

Before Seeherman, Bucher, Cataldo,
Administrative Law Judges

By the Board:

This case now comes up on applicant's motion to dismiss. Opposer has filed an opposition to the registration of the mark ALEXANDRA DA VINCI for a broad range of cosmetics and toiletry items in Class 3, including dentifrices.[1]

Registration has been opposed by Da Vinci Dental Studios, Inc. ("opposer") on the grounds of likelihood of confusion with its mark DA VINCI as used on, or in connection with, "various goods and services relating to the improvement of personal appearance" and dilution of its DA

[1] Application Serial No. 75/796383 was filed September 10, 1999 based on an allegation of a bona fide intention to use the mark in commerce and asserting a claim of priority, under Section 44(d) of the Trademark Act, based on the filing of an application on June 25 1999 in Italy. Subsequently, applicant deleted its application basis under Section 1(b) of the Trademark Act and submitted, under Section 44(e) of the Trademark Act, a certified copy of its Italian registration that issued from its priority application.

VINCI mark. In its notice of opposition, opposer alleges, in relevant part, as follows:

1. Opposer is the owner of all right, title, and interest in and to the mark DA VINCI ("DA VINCI Mark"), which opposer has used in connection with various goods and services relating to improvement of personal appearance, since as least as early as September, 1970.

2. Opposer's rights in the DA VINCI Mark have been recognized by the Patent and Trademark Office, which issued Registration No. 2,061,195 for the mark DA VINCI DENTAL STUDIOS on May 13, 1997, to DANIEL MATERDOMINI, which has been used by Opposer and/or owned by Opposer since the mark was first adopted.

3. Opposer’s DA VINCI Mark has been used, advertised and promoted in interstate commerce from a date long prior to the filing date of Applicant’s application for ALEXANDRA DA VINCI, which is based upon an intent to use and/or foreign rights, filed in the United States on September 10, 1999, in turn also based upon an earliest Italian registration filing date of June 25, 1999. Therefore, Opposer clearly holds priority to the DA VINCI Mark in the United States.

Concurrently with an answer, applicant filed a motion to dismiss the proceeding under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted. The motion has been fully briefed.

In support of its motion, applicant contends that opposer lacks standing to oppose applicant’s mark because opposer is not the owner of the pleaded registered mark. Specifically, applicant states that paragraph 2 of the notice of opposition indicates a third party, Daniel Materdomini, owns the registered mark; that opposer has not

alleged any privity with the owner; and that opposer therefore has failed to establish that it has a "'real interest' in the proceeding or a 'reasonable belief' that it will be damaged."

In response, opposer contends that applicant's assertions that opposer does not own the registered mark are "untrue as can be seen from the face of the Notice of Opposition." Opposer argues that its statement that the registered mark "has been used and/or owned by Opposer since the mark was first adopted" is a "clear, correct and properly plead [sic] statement that establishes standing" in this proceeding. In addition, opposer indicates in its brief that Daniel Materdomini is its founder and he assigned the registered mark to opposer in 2001. As such, opposer contends its ownership and right to the mark are clearly set forth.

Moreover, opposer asserts that even if it did not own the pleaded registered mark it would still have standing because ownership of a federally registered mark is not required for purposes of standing and opposer has "alleged facts that show that it will be damaged by a likelihood of consumer confusion, as well as dilution of its trademark…."

In addition to meeting the broad requirements of Section 13 of the Trademark Act that a person have a belief that he would suffer some kind of damage if the mark is

registered, an opposer must meet two judicially-created requirements in order to have standing: (1) the opposer must have a "real interest" in the proceeding; and (2) the opposer must have a "reasonable" basis for his belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092; 50 USPQ2d 1023 (Fed. Cir. 1999).

After a careful review of the notice of opposition, we find that opposer has not adequately pled a real interest and a reasonable basis for its belief of damage. The facts as alleged fail to sufficiently indicate opposer's ownership and use of the registered mark and fail to adequately set forth the nature of the relationship between opposer and Daniel Materdomini, the party asserted in the notice of opposition to be the original owner of the registration.

In view thereof, the motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted is hereby granted.

Nonetheless, the Board freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient. Accordingly, opposer is allowed until **twenty days** from the mailing date of this order to file an amended pleading consistent with the discussion above, failing which the opposition will be dismissed with prejudice. In addition, opposer should identify the "goods and services relating to improvement of

personal appearance” on which it uses its DA VINCI mark with greater specificity.

Proceedings are otherwise suspended. When proceedings resume, the Board will reset trial dates, including the closing date of discovery, as well as applicant's time in which to file its answer to the amended notice of opposition.